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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/657,335	<b>Applicant(s)</b> HABERMAN ET AL.
	<b>Examiner</b> KUNAL LANGHNOJA	<b>Art Unit</b> 2427

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 17 November 2008.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-9 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-9 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 02 February 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-146/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date _____	6) <input type="checkbox"/> Other: _____

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed on 10/17/2008 have been fully considered but they are not persuasive.

Regarding claim 1, Applicant argues cited reference, Nemirofsky et al does not teach claimed limitations. Furthermore, applicant argues that reference creates segments specifically for audience in advance and not from plurality of smaller segments. However, the examiner respectfully disagrees with the applicant. As cited earlier in the office action, the reference provides for customizing programs for particular audiences such that program played in one location could be different from that played in another. Wherein, multiple market-specific segments 22 can be inserted into network-wide program 20 depending on particular audiences. Since program played in one location can be different from program played in another, multiple segments are interchangeable to target audiences in different market without creating multiple unique programs.

Regarding claim 2, Applicant argues that cited reference Nemirofsky does not meet claimed limitation. Furthermore, Applicant argues that "described that the actual assembled message is assembled after the segments are sent to storage at, for example, an upstream location, and prior to assembly of the "message." However, the examiner respectfully disagrees with the applicant. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., sent to storage) are not recited in the

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rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1-4,6 and 8-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Nemirofsky et al (United States Patent 5,761,601), hereinafter, referenced as Nemirofsky.**

Regarding claim 1, Nemirofsky discloses video distribution of advertisement to businesses. In addition, Nemirofsky discloses ability to tailor its commercial messages to particular chains, stores, aisles, times of day and geographic regions, the distribution network of the present invention provides advertisers the capability to reach target audiences with customized messages, which reads on claimed "creating a message campaign, said message campaign allowing the creation of a plurality of different messages to targeted audiences, wherein a specific targeted audience receives a selected one of said plurality of different messages based upon criteria of said specific targeted audience." Wherein, commercial messages reads on claimed "message campaign", commercial messages to particular chains, stores, aisles, times of day and

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geographic regions among reads on claimed "plurality of different messages to targeted audiences", and ability to tailor its commercial messages to particular chains, stores, aisles, times of day and geographic regions reads on claimed "a specific targeted audience receives a selected one of said plurality of different messages based upon criteria of said specific targeted audience", as disclosed in lines 53-57 of column 3, method comprising,

the invention provides for customizing programs for particular target audiences or markets, such that the program played in one receiving site could be quite different from that played in another. Equally important is the invention's on-line insertion of custom, market-specific segments, which reads on claimed "providing a plurality of media segments, said media segments for assembly into said plurality of different messages to targeted audiences, wherein at least one of said media segments is interchangeable with another one of said media segments." Wherein, market-specific segments reads on claimed "providing a plurality of media segments", target audiences or markets, such that the program played in one receiving site could be quite different from that played in another reads on claimed "media segments for assembly into said plurality of different messages to targeted audiences", and since market specific segments played in one receiving site is different from one played in another reads on claimed "segments is interchangeable with another one of said media segments", as disclosed in lines 11-15 of column 5

Data insertion unit 38 encodes a destination address along with a package of control data in the network-wide program 20 and market-specific segments. The

destination address will correspond to one or more receiving sites, groups of receiving sites, or sub-parts of receiving sites in the network. The control data may include, as elaborated below, switching commands, program/segment storage commands, messages directed to a host computer at the receiving site, modem commands for a modem at the receiving site, receiving site control profile updates, and the like. Data insertion unit 38 operates under commands from system control computer 26, programmed through traffic control computer 24, which dictate what addresses and control data are to be assigned to each market-specific segments, which reads on claimed "providing assembly information regarding how said plurality of media segments may be assembled to create said plurality of different messages to targeted audiences." wherein, data insertion unit reads on claimed "assembly information", data insertion unit 38 operates under commands from system control computer 26, programmed through traffic control computer 24, which dictate what addresses and control data are to be assigned to each market-specific segments reads on claimed "assembled to create said plurality of different messages to targeted audiences" as disclosed in lines 50-65 of column 6

data insertion unit 38 operates under commands from system control computer 26, programmed through traffic control computer 24, which dictate what addresses and control data are to be assigned to each market-specific segments reads on claimed reads on claimed "associating said assembly information with said plurality of media segments", as disclosed in lines 60-65 of column 6

**Regarding claim 2,** Nemirofsky discloses everything claimed (see claim 1), in addition, Nemirofsky discloses customizing programs for particular target audiences or markets, such that the program played in one receiving site could be quite different from that played in another. Equally important is the invention's on-line insertion of custom, market-specific segments in a general, network-wide program without the need for pre-assembly of each unique program. Furthermore, Nemirofsky discloses data insertion unit 38 encodes a destination address along with a package of control data in the network-wide program 20 and market-specific segments. The destination address will correspond to one or more receiving sites, groups of receiving sites, or sub-parts of receiving sites in the network. The control data may include, as elaborated below, switching commands, program/segment storage commands, messages directed to a host computer at the receiving site, modem commands for a modem at the receiving site, receiving site control profile updates, and the like. Data insertion unit 38 operates under commands from system control computer 26, programmed through traffic control computer 24, which dictate what addresses and control data are to be assigned to each market-specific segments, which reads on "message for a specific targeted audience is assembled at a later time, said message being assembled based upon said assembly information, said plurality of media segments, and on information regarding said target audience." Wherein, customized programs are put together based on the target audiences and market at the receiving location which reads on claimed "message for a specific targeted audience is assembled at a later time", data insertion unit 38 encodes a destination address along with a package of control data reads on claimed "based

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upon said assembly information", customizing programs for particular target audiences or markets, such that the program played in one receiving site could be quite different from that played in another reads on claimed "plurality of media segments", and particular target audiences or markets reads on claimed "information regarding said target audience", as disclosed in lines 10-18 of column5, and lines 50-65 of column 6.

**Regarding claim 3,** Nemirofsky discloses everything claimed (see claim 2), in addition, Nemirofsky discloses customizing programs for particular target audiences or markets, such that the program played in one receiving site could be quite different from that played in another. Equally important is the invention's on-line insertion of custom, market-specific segments in a general, network-wide program without the need for pre-assembly of each unique program, which reads on claimed "at least one media segment used to assemble one of said specific messages is created at said later time." wherein, customization of programs for particular audiences or market is put together at the receiving location reads on claimed "assemble one of said specific messages is created at said later time", as disclosed in lines 10-18 of column 5.

**Regarding claim 4,** Nemirofsky discloses everything claimed (see claim 2), in addition, Nemirofsky discloses data insertion unit 38 encodes a destination address along with a package of control data in the network-wide program 20 and market-specific segments. The destination address will correspond to one or more receiving sites, groups of receiving sites, or sub-parts of receiving sites in the network. The control data may include, as elaborated below, switching commands, program/segment storage commands, messages directed to a host computer at the receiving site, modem

commands for a modem at the receiving site, receiving site control profile updates, and the like. Data insertion unit 38 operates under commands from system control computer 26, programmed through traffic control computer 24, which dictate what addresses and control data are to be assigned to each market-specific segments, which reads on claimed "assembly information includes rules for use at said later time, said rules for use in determining which of said plurality of said media segments to use in assembling a message for said specific targeted audience, based on said information regarding said target audience." Wherein, data insertion unit 38 encodes a destination address along with a package of control data in the network-wide program 20 and market-specific segments reads on claimed "assembly information includes rules for use at said later time", Data insertion unit 38 operates under commands from system control computer 26, programmed through traffic control computer 24, which dictate what addresses and control data are to be assigned to each market-specific segments reads on claimed "said rules for use in determining which of said plurality of said media segments to use in assembling a message for said specific targeted audience", and market specific reads on claimed "target audience", as disclosed in lines 50-65 of column 6.

**Regarding claim 6,** Nemirofsky discloses everything claimed (see claim 1), in addition, Nemirofsky discloses network-wide program 20 and the market-specific segments 22 are preferably in full motion video format, and include both an audio and video component recorded onto conventional recording media, which reads on claimed "media segments include audio, video, voice overs, and background music." wherein,

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audio reads on claimed "audio", "voice over", "background music", and video reads on claimed "video", as disclosed in lines 52-55 of column 5.

**Regarding claim 8**, Nemirofsky discloses everything claimed (see claim 1), in addition, Nemirofsky discloses insertion control unit with control data embedded in the video signal. The video program schedule (a3) describes the individual video programs or segments on all the video channels flowing through the uplink (j): event name, event serial number, channel number, start date and time and stop date and time. The group control schedule database (a4) defines the control commands for the insertion control units within a particular group: switching commands according to events in the video program schedule, and recording, cuing and playing of video program segments in the receiving site's video storage bank, which reads on claimed "assembly information includes data representing time segments; said media segments, and conditions." Wherein, control unit with control data reads on claimed "assembly information", start date and time and stop date and time reads on claimed "time segments", event name, event serial number reads on claimed "media segment", and defining the control commands for the insertion control units within a particular group reads on claimed "conditions", as disclosed in lines 55-68 of column 12

**Regarding claim 9**, Nemirofsky discloses everything claimed (see claim 2), in addition, Nemirofsky discloses receiver 54 contains insertion control unit 56 in decoding and switching system 12. Receiver 54 receives the play list from the trafficking system via satellite 8 and interprets the play list in order to drive the segments that are to be displayed on the monitors. Furthermore, Nemirofsky discloses A header is placed on

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each segment so that regional receiver 54 only saves the part of the signal carrying the segment needed in its region. Receiver 54 also receives periodic updates in this manner, which reads on claimed "message for a specific targeted audience is assembled in a set top box for a television receiver contemporaneously with displaying said message to said specific targeted audience." Wherein, receiver 54 only saves the part of the signal carrying the segment needed in its region reads on claimed "message for a specific targeted audience is assembled in a set top box for a television receiver", segments that are to be displayed on the monitors reads on claimed "displaying said message to said specific targeted audience", as disclosed in lines 25-40 of column 21.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky, in view of Khusheim et al( United States Patent Publication 2003/0221191), hereinafter, referenced as Khusheim.**

Regarding claim 5, Nemirofsky discloses everything claimed (see claim 4), however, Nemirofsky fails to disclose "rules include default conditions for determining which of said plurality of said media segments to use when no appropriate information regarding said target audience is available." However, the examiner maintains that it was well known to provide method with "rules include default conditions for determining

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which of said plurality of said media segments to use when no appropriate information regarding said target audience is available", as taught by Khusheim.

In the similar field of endeavor, Khusheim discloses system and method of directed television and radio advertising. In addition, Khusheim discloses

step 304, where it is determined whether the received commercial message matches a default criteria and/or at least one user-profile criteria stored in user information database 124. When a received commercial message does not match the default criteria or at least one user profile criteria stored in user information database 124, the received commercial message is discarded and flow returns to step 300.

When, at step 304, the received message matches the default criteria and/or at least one user profile criteria, flow continues to step 308 where the received message is stored in commercial message database 128, which reads on claimed "rules include default conditions for determining which of said plurality of said media segments to use when no appropriate information regarding said target audience is available." Wherein, a default criteria read on claimed "default conditions", message does not match the default criteria or at least one user profile criteria stored in user information database reads on claimed "when no appropriate information regarding said target audience is available", and message is received after passing the default criteria reads on claimed "said media segments to use", as disclosed in lines 15-26 of paragraph 0054

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Nemirofsky by specifically providing method with "rules include default conditions for determining which of said plurality of said media

segments to use when no appropriate information regarding said target audience is available", as taught by Khusheim for the purpose of sending customized programs with market specific message to target audiences or markets.

**6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nemirofsky, in view of Matthews et al( United States Patent RE38,376), hereinafter referenced as Matthews.**

Regarding claim 7, Nemirofsky discloses everything claimed (see claim 1), however, Nemirofsky fails to disclose "a subset of said plurality of media segments form a default generic message." The examiner maintains that it was well known to provide method with a step of "a subset of said plurality of media segments form a default generic message", as taught by Matthews.

In the similar field of endeavor, Matthews discloses message delivery method for interactive televideo system. In addition, Matthews discloses Dialog message block 100 includes a title segment 106a, a text body segment 106b, and a close prompt segment 106c. As suggested by the close prompt segment 106c, dialog message block 102 remains on display screen 98 and over the selected programming until a viewer acknowledges the message by pressing action key 91 on viewer control unit 71, or the expiration of a default message period, which reads on claimed "a subset of said plurality of media segments form a default generic message". Wherein, title segment 106a, a text body segment 106b, and a close prompt segment 106c reads on claimed "subset of plurality of segments", and segments produces expiration of a default

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message period reads on claimed "form a default generic message", as disclosed in lines 30-38 of column 5.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Nemirofsky by specifically providing method with "a subset of said plurality of media segments form a default generic message", as taught by Matthews for informing users with status of an interrupted program.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KUNAL LANGHNOJA whose telephone number is 571-270-3583. The examiner can normally be reached on M-F 9 A.M- 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Scott Beliveau can be reached on 571-272-7343. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason P Salce/  
Primary Examiner, Art Unit 2421

01/12/2009

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